

REMARKS

Claims 1 and 3 through 11 are pending in this application, of which claims 7 through 11 stand withdrawn from consideration pursuant to the provisions of 37 C.F.R. § 1.142(b). Accordingly, claims 1 and 3 through 6 are active.

Claims 1, 5 and 6 have been amended. Care has been exercised to avoid the introduction of new matter. Indeed, adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure as, for example, the paragraph bridging pages 8 and 9 of the written description of the specification. Applicant notes that the amendments to claims 5 and 6 address formalistic issues. Applicant submits that the present Amendment does not generate any new matter issued.

Telephonic Interviews

Applicants acknowledge, with appreciation, Examiner Owens's courtesy in conducting telephonic interviews on May 4 and May 5, 2004. During such telephonic interviews the present claim amendments was discussed. Examiner Owens agreed that the present claim amendments would overcome the imposed prior art rejections. For completeness each of the imposed rejections is addressed.

Claims 5 and 6 were rejected under the second paragraph of 35 U.S.C. § 112.

In the statement of the rejection the Examiner identified an informality in claims 5 and 6 stemming from the dependency of claim 5 on cancelled claim 2. This rejection is traversed.

In response, claims 5 and 6 have been amended by changing the dependency to independent claim 1, thereby overcoming the stated basis for the imposed rejection. Accordingly, withdrawal of the rejection of claims 5 and 6 under the second paragraph of 35 U.S.C. § 112 is solicited.

Claims 1, 3 and 4 were rejected under 35 U.S.C. § 102 for lack of novelty is evidenced by Hashimoto et al.

In the statement of the rejection the Examiner asserted that the surface of the active region adjacent gate 15' is inclined toward the isolation region, pointing to Fig. 1(a). This rejection is traversed.

The factual determination for lack of novelty under 35 U.S.C. §102 requires the identical disclosure in a single reference of each element of the claimed invention such that the identically claimed invention is placed into the recognized possession of one having ordinary skill in the art. *Crown Operations International, Ltd. v. Solutia, Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002); *Helifix Ltd. v. Blok-Lok, Ltd.* 208 F.3d 1339, 54 USPQ2d 1299 (Fed. Cir. 2000); *Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994). Further, in imposing a rejection under 35 U.S.C. §102, the Examiner is required to point to “page and line” of a reference wherein each feature of a claimed invention asserted to be disclosed. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984). There is a functionally significant structural difference between the claimed invention and the semiconductor

device disclosed by Hashimoto et al. that scotches the factual determination that Hashimoto et al. identically describe the claimed invention within the meaning of 35 U.S.C. §102.

Specifically, the invention defined in independent claim 1 is directed to a semiconductor device comprising, inter alia, an active region surface which is entirely rounded and inclined downward toward the isolation region. The Examiner alleged that Hashimoto et al. disclose a semiconductor device wherein a surface of the active region is rounded referring to Fig. 1(a). Indeed, even the Examiner recognizes that only a portion of the identified surface of the active region is rounded. The simple fact should be stated -- Hashimoto et al. **do not**, repeat **not**, disclose or even suggest that the surface of the active region is entirely rounded as in the claimed invention.

Moreover, drawings are **not** drawn to scale and, hence, **cannot** be relied upon to establish claimed features if the specification is silent. *Huckerson-Halberstadt, Inc. v. AVAV Group International, Inc.* ___ F.3d ___, 55 USPQ2d 1487 (Fed. Cir. 2000). See, also, *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986) and *In re Olson*, 212 F.2d 590, 101 USPQ 401 (CCPA 1954).

Even if Fig. 1(a) of Hashimoto et al. is consulted, it becomes apparent that what Hashimoto et al. do disclose is that the slope of the edge portion of the field oxide film 2 in the circuit area is gentler than that of the field oxide film 2 in the memory cell area, and that lateral extension (bird's beak) of the field oxide film 2 in the circuit area is longer than that of the field oxide film 2 in the memory cell area. However, Hashimoto et al. neither disclose nor suggest that the active region is **entirely** oxidized when the field oxide film is formed. Accordingly, the active region of the semiconductor device disclosed by Hashimoto et al.

inevitably includes a flat portion, and in that device the surface of the active region is not entirely rounded.

Further evidence of the lack of a factual basis to support the imposed rejection is apparent from comparing Figs. 18A and 18B of the present invention with Fig. 1(a) of Hashimoto et al. In the present invention, the active region is entirely oxidized and, hence, the surface of the active region in an access MOS transistor portion is lower than that of a driver MOS transistor portion. In contradistinction to the present invention, in accordance with the teachings of Hashimoto et al., the height of the surface of the active region in the circuit area is the same as that in the memory cell area. In other words, the active region is not entirely oxidized and the surface of the active region is not entirely rounded in the semiconductor device disclosed by Hashimoto et al.

The above-argued structural difference between the claimed invention and the semiconductor device disclosed by Hashimoto et al. undermines the factual determination that Hashimoto et al. identically describe the claimed invention within the meaning of 35 U.S.C. §102. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, *supra*. Applicant, therefore, submits that the imposed rejection of claims 1, 3 and 4 under 35 U.S.C. §102 for lack of novelty is evidenced by Hashimoto et al. is not factually viable, hence, solicits withdrawal thereof.

Claims 5 and 6 were rejected under 35 U.S.C. §103 for obviousness predicated by Hashimoto et al. in view of Ando et al.

This rejection is traversed. Specifically, each of claims 5 and 6 depends from independent claim 1. Applicant incorporates herein the arguments previously advanced in traversing the imposed rejection of claim 1 under 35 U.S.C. §102 for lack of novelty evidenced by Hashimoto et al. Indeed, Hashimoto, et al. neither disclose nor suggest a semiconductor device as defined in independent claim 1, comprising, inter alia., an active region having a surface which is **entirely** rounded. The additional reference to Ando et al. does not cure the argued deficiencies of Hashimoto et al. Accordingly, even if the applied references are combined, the claimed invention would **not** result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988).

Applicant, therefore, submits that the imposed rejection of claims 5 and 6 under 35 U.S.C. §103 for obviousness predicated upon Hashimoto et al. in view Ando et al. is not factually or legally viable, and hence, solicits withdrawal thereof.


Based upon the foregoing, it should be apparent that the imposed rejections have been overcome and that all pending claims are in condition for immediate allowance. Favorable consideration is, therefore, respectfully solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

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Respectfully submitted,

MCDERMOTT WILL & EMERY LLP

A handwritten signature in black ink, appearing to read 'A. Steiner', is written over the printed name.

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